

BS00023

U.S. Application No. 09/751,809 Examiner Brown, Art Unit 2611
Submission of Amendment with RCE in Response to June 2, 2005 Final Office Action

REMARKS

In response to the final Office Action dated June 2, 2005, Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the amended claims distinguish over the cited documents of record.

The United States Patent and Trademark Office (the "Office") finally rejected claims 20-24 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,191,645 to Carlucci *et al.* Claims 6-8 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,675,384 to Block in view of U.S. Patent 5,737,552 to Lavallee. Claims 9 and 19 were rejected under 35 U.S.C. § 103 (a) as being obvious over Block in view of U.S. Patent 5,973,683 to Cragun. The Assignee shows, however, that the pending claims are not anticipated nor obviated by any combination of Carlucci, Block, Lavallee, and Cragun. The Assignee thus respectfully submits that the pending claims distinguish over the cited documents.

Rejection of Claims 20-24

The United States Patent and Trademark Office (the "Office") finally rejected claims 20-24 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,191,645 to Carlucci *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims patentably distinguish over Carlucci. The reference to Carlucci does not anticipate the claims, so the Assignee respectfully requests that Examiner Brown to remove the 35 U.S.C. § 102 (b) rejection.

Claims 20-24 have been amended. Independent claim 20, for example, receives frames of program data, with each frame associated with a discrete portion of a program. The program

BS00023

U.S. Application No. 09/751,809 Examiner Brown, Art Unit 2611
Submission of Amendment with RCE in Response to June 2, 2005 Final Office Action

data comprises control instructions that alter a portion of a display screen at specified coordinates. The portion of the display screen is then replaced with alternate content. Support for such features may be found at least at page 4, lines 12-13; at page 12, Table 1; at page 16, lines 17-21; at page 17, lines 1-5; and at page 22, lines 12-16. A "clean" version of amended claim 20 is reproduced below.

20. A method for formulating and delivering data for use in controlling presentation of a program and portions thereof, the method comprising:

receiving program data associated with a discrete portion of the program, the program data comprising control instructions that alter a portion of a display screen at specified coordinates;

accessing alternate content selected by the viewer; and

replacing only the portion of the display screen with the alternate content.

The reference to *Carlucci* does not anticipate the claims. *Carlucci* fails to recognize that program data may comprise control instructions that specify coordinates to alter a portion of a display screen, and only that portion of the display screen is replaced with alternate content selected by the viewer. Because *Carlucci* is silent to such features, the patent to *Carlucci et al.* cannot anticipate the claims. Examiner Brown is thus respectfully requested to remove the § 102 rejection.

Rejection of Claims 6-8

Claims 6-8 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,675,384 to Block in view of U.S. Patent 5,737,552 to Lavallee. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested

BS00023

U.S. Application No. 09/751,809 Examiner Brown, Art Unit 2611
Submission of Amendment with RCE in Response to June 2, 2005 Final Office Action

by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 6-8 are not obvious in view of *Block* and *Lavallee*. The proposed combination of *Block* and *Lavallee* fails to teach or suggest many features recited in claims 6-8. Claim 6, for example, formulates frames of program data comprising content and control data. The control data comprises control instructions to alter a display screen at coordinates specified by the control data. The program data is delivered to a transmission facility and distributed to viewers. Claim 7 blocks a portion of the display screen at the coordinates specified by the control data, while claim 8 recites blurring a portion of the display screen at the coordinates specified by the control data. The proposed combination of *Block* and *Lavallee* completely fails to teach or suggest such features. One of ordinary skill in the art, then, would not think the pending claims obvious in view of *Block* and *Lavallee*. The Assignee, then, respectfully requests removal of the § 103 rejection.

Rejection of Claims 9 & 19

Claims 9 and 19 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Block* in view of U.S. Patent 5,973,683 to Cragun. Claims 9 and 19, however, are not obvious in view of *Block* and *Cragun*. The proposed combination of *Block* and *Cragun* fails to teach or suggest many features recited in claims 9 and 19. Claim 9, for example, formulates "frames of program data ..., wherein the program data comprises ... content and control data, the control data comprising control instructions to alter a display screen at coordinates specified by the control data." That program data is delivered to a transmission facility and distributed to viewers by embedding the program data in a channel carrying an Electronic Programming Guide. The proposed combination of *Block* and *Cragun* fails to teach or suggest all these features, so one of ordinary skill in the art would not think claim 9 obvious.

Claim 19 is similarly not obvious. Claim 19 sends program data over a communications network to a consumer electronics device associated with a viewer. An instruction is received

BS00023

U.S. Application No. 09/751,809 Examiner Brown, Art Unit 2611
Submission of Amendment with RCE in Response to June 2, 2005 Final Office Action

from the viewer to alter the program according to the viewer's presentation preferences. Control instructions are sent to alter a portion of a display screen at coordinates specified by the control instructions. Because the proposed combination of *Block* and *Cragun* fails to teach or suggest all these features, one of ordinary skill in the art would not think claim 19 obvious.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390